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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,902	12/19/2001	Deborah Wenzel	3596.02-2	4490

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EXAMINER

JOHNSON, JERRY D

ART UNIT

PAPER NUMBER

1764

DATE MAILED: 08/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,902

Applicant(s)

WENZEL, DEBORAH

Examiner

Jerry D. Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-29 are replete with indefinite and/or incorrect terms. Additionally, numerous claims fail to positively recite the components of the claimed composition. Accordingly, it is impossible to determine just what is being claimed. Specific examples are:

In claim 1, Markush groups are required to use the terminology "selected from the group consisting of". Markush groups are also to use the term "and" as opposed to "or". In a(ii), the term "by volume" is not understood. Claim 1, line 28 recites "alkyl, alkenyl or alkynyl having between about 10 to 24 carbon atoms, with". It is unclear if the composition may contain component "d" without component "e" or if a composition containing component "d" must also contain component "e". In component "e", the recitation "wherein trialkylamines are excluded" is not understood. It is unclear how the recitation "having viscosity similar to that of the liquid combustible fuel" modifies, or is intended to modify, the recitation "where the ratio of combustible fuel:additive ranges from about 99:1 to 0:100 by volume". Especially considering that claim 1 does not contain additional "combustible fuel". Claim 1 is rendered indefinite by the recitation that the composition excludes "aromatic organic compounds" and also excludes "compounds of phenanthrene", i.e., phenanthrene is an aromatic organic compound. Claim 1 is rendered indefinite by the recitation "(e.g., alkyl or alkenyl)". Claim 1 is rendered indefinite by

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the recitation “other organic diacids are excluded”, i.e., the claim fails to define which organic acids are excluded.

Claim 2 fails to positively recite the composition, i.e., it appears that claim 2 should be amended to recite “The additive composition of claim 1 comprising. . .”.

Claim 2 lacks antecedent basis to recite “the refined combustible fuel”. Additionally, it is unclear how the recitation “having a viscosity similar to that of the liquid combustible fuel” modifies, or is intended to modify, the recitation “where the ratio of combustible fuel:additive ranges from about 99:1 to 1:99 by volume”. Especially considering that claim 2 does not contain additional “combustible fuel”.

Claim 3 fails to positively recite the composition, i.e., it appears that claim 3 should be amended to recite “The additive composition of claim 1 comprising . . .”.

In claim 3, component “b”, improperly recites “one or more alcohols selected from the group consisting of alcohols, iso-propanol and butanol”. Additionally, it is unclear how the recitation “having a viscosity similar to that of the liquid combustible fuel” modifies, or is intended to modify, the recitation “where the ratio of combustible fuel:additive ranges from about 90:10 to 95:5 by volume”. Especially considering that claim 3 does not contain additional “combustible fuel”.

Claim 4 fails to positively recite the composition, i.e., it appears that claim 4 should be amended to recite “The additive composition of claim 1 comprising . . .”.

Claim 4 is rendered indefinite by the recitation “alcohols having between about 1 and 5 carbon atoms as defined herein” (emphasis added).

Similar rejections under 35 U.S.C. § 112 2nd paragraph also apply to claims 5-28.

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Claim 29 fails to particularly point out and distinctly claim the “soluble alcohol” used in step “a”, i.e., the claim fails to define what the alcohol must be soluble with or in (e.g., diesel fuel, fatty acid, water, etc.). The “(“ in the 10th line of claim 29 appears to be misplaced. The proviso that begins in the 10th line of claim 29 is confusing and renders the claim indefinite.

Examination of this application reveals that it appears to be drawn to numerous different, distinct, and independent inventions. Because the claims are cast in such form (as discussed above) and set forth so many possible additive products and compositions containing said products, it is impossible to list all of the different, distinct, and independent inventions present. Accordingly, at this time, restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-28, drawn to an additive composition or combustible fuel, classified in class 44, subclass 302.
- II. Claim 29, drawn to a method of determining the suitability of a composition as a useful additive to a combustible fuel to improve combustion, classified in class 44, subclass 903.

The inventions are distinct, each from the other because of the following reasons: Inventions Group I and Group II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions, i.e., claims 1-28 are directed to a composition comprising a combination of specific additives whereas claim 29 is directed to a method of

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determining the suitability of a composition as a useful additive to a combustible fuel and is not limited to the additive(s) of claims 1-28.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

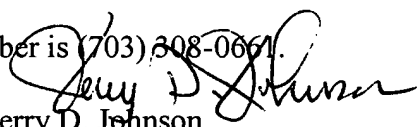
Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143)

If applicant elects claims 1-28, then further restriction and/or election may be required when the above noted indefiniteness has been overcome.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry D. Johnson whose telephone number is (703) 308-2515. The examiner can normally be reached on 6:00-3:30, M-F, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Caldarola can be reached on (703) 308-6824. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-5408 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Jerry D. Johnson
Primary Examiner
Art Unit 1764

JDJ
August 6, 2003